

56145473-8

REMARKS

Claims 1, 7-13, 15-18 and 20-36 are pending in this application, as claims 33-36 were added.

Applicant thanks the Examiner for supplying documents in support of the Official Notice taken in the previous Office Action.

Rejection Under 35 U.S.C. § 103(a) as Being Unpatentable Over Yap and Pitroda

Claims 1, 7-13, 15-18 and 20-32 were rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent Application No. 2002/0059366 ("Yap") and U.S. Patent No. 5,884,271 ("Pitroda"), each in view of the other.

The Office Action also states that Microsoft was known to trade icon presence and position on the desktop operating system, for example, ISP set-up icons, for valuable favors. Further, the Office Action asserts that "[v]ersions of the operating system such as ME would display icons more prominently based on frequency of use or the last use. Several references were provided in support of these alleged Microsoft teachings, including documents entitled "Taskbar Basics", "Disable personalized menus", "Adjust taskbar and Start menu options", "Screenshot of Examiners Desktop", "Who owns the desktop", "MS is NOT price gouging on Windows - DoJ expert" and "Farewell to FUD".

56145473-8

Applicant respectfully submits that Yap, Pitroda and the above teachings do not teach or suggest, alone or in combination, every element recited in independent claims 1, 13 and 18 as amended, including:

- "a first display location being reserved for one of the plurality of symbols associated with the most frequently used application program", as recited in amended independent claims 1, 13 and 18.

Regarding this limitation, the Office Action states that "[v]ersions of the operating system such as ME would display icons more prominently based on frequency of use" Applicant, however, was unable to locate any teaching or suggestion regarding "frequency of use" in the cited references and also no teaching or suggestion of reserving a first display location for a symbol, as recited in amended claims 1, 13 and 18. Rather, the references disclose the apparent value associated with icon placement and moving recently used icons to the top of a menu in a list. See, for example, article entitled "Who owns the desktop?" and the document entitled "Disable personalized menus".

Hence, it would not have been obvious to a person having ordinary skill in the art at the time of the invention to reserve a first display location for a symbol associated with the most frequently used application program. Accordingly, Applicant

56145473-8

respectfully submits that amended independent claims 1, 13 and 18 are patentable over Yap, Pitroda and the Microsoft® teachings, alone or in combination.

Claims 7-12, claims 15-17 and claims 20-23 depend from and further limit claims 1, 13 and 18, respectively, and, for at least the reasons stated above in connection with claims 1, 13 and 18, are patentable over Pitroda and Yap, in view of each other, and the alleged teachings of Microsoft.

Further, Applicants respectfully submit that independent claims 24, 27 and 30 are patentable since Yap, Pitroda and the alleged teachings of Microsoft, alone or in combination, do not teach or suggest every element recited in those respective claims. Specifically, as to independent claims 24, 27 and 30, the cited references fail to teach or suggest:

- "determining how prominent at least one of the plurality of symbols is displayed, one of the plurality of symbols associated with the most frequently used application program being displayed more prominently than the other symbols", as recited in claim 24;
- "determining how prominent at least one of the plurality of symbols is displayed, one of the plurality of symbols associated with the last used

56145473-8

application program being displayed more prominently than the other symbols" as recited in new claim 27; and

- "determining how prominent at least one of the plurality of symbols is displayed, one of the plurality of symbols associated with a provider of an application program paying a premium to an issuer of the smart card being more prominently displayed than the other symbols", as recited in new claim 30.

Rather, the appearance of a respective icon/options in Yap, in Pitroda and in the Microsoft teachings remain unchanged regardless of the frequency of use of the associated application, regardless if the respective icon/option is associated with the last used application and regardless if a premium is paid. The Office Action states that the document entitled "Adjust taskbar and Start menu options" illustrates a large icon leading to the Netscape home page. Applicant respectfully submits that regardless whether of the Netscape icon or any other icon is more prominently displayed in the cited document, Yap, Pitroda and the Microsoft teaching do not teach or suggest more prominently displaying a symbol based on frequency of use of an associated application program (as recited in claim 24), based on the last used application program associated with the associated symbol (as recited in amended claim 27) and

56145473-8

based on a premium paid to an issuer of the smart card (as recited in claim 30).

Accordingly, Applicant respectfully submits that independent claims 24, 27 and 30 are patentable over Yap, Pitroda and the Microsoft teachings, alone or in combination.

Claims 25-26, claims 28-29 and claims 31-32 depend from and further limit claims 24, 27 and 30, respectively, and, for at least the reasons stated above in connection with claims 24, 27 and 30, are patentable over Pitroda and Yap, in view of each other, and the alleged teachings of Microsoft.

Applicant has also added new independent claims 33-36 to the present application. Applicant believes that these claims are also patentable over Yap and Pitroda, in view of each other, and the alleged teachings of Microsoft because these references fail to teach or suggest:

- "a first display location being reserved for one of the plurality of symbols associated with the last used application program", as recited in new claims 33 and 35; and
- "a first display location being reserved for one of the plurality of symbols associated with a provider of one of the plurality of application programs paying a premium to

56145473-8

an issuer of the smart card", as recited in new claims 34 and 36.

The Office Action states that "[v]ersions of the operating system such as ME would display icons more prominently based on ... the last use." Moreover, the Office Action refers to a document entitled "Disable personalized menus" for teaching "that Windows moves recently used icons to the top [first] of the menu, and hides items not recently used". Applicant, however, respectfully submits that this document does not teach or suggest reserving a first display location for a symbol associated with the last used application program or a symbol associated with a provider of one of the plurality of application programs paying a premium to an issuer of the smart card. Rather, the document disclosure moving recently used icons to the top of a menu in a list.

Indeed, the undersigned attorney tried this functionality offered by Microsoft in Windows 2000 and confirmed that Microsoft does in fact select and organize a group of recently used icons, but those recently used icons are arranged in a random fashion.

Furthermore, Applicant respectfully submits that the cited references do not teach or suggest a first display location being reserved for one of the plurality of symbols associated

56145473-8

with a provider of one of the plurality of application programs paying a premium to an issuer of the smart card, as recited in new claims 34 and 36. Rather, the references simply acknowledge the apparent value associated with icon placement. See, for example, article entitled "Who owns the desktop?"

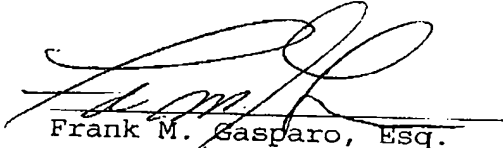
Accordingly, Applicant respectfully submits that independent claims 33-36 are patentable over Yap, Pitroda and the Microsoft teachings, alone or in combination.

In addition to the lack of a teaching or suggestion in Pitroda, Yap and the alleged teachings of Microsoft® as described above, there is no suggestion or motivation to combine the references. See MPEP § 2143.01.

Entry of this amendment and favorable reconsideration of this application are earnestly solicited. Should the Examiner have any questions or wish to discuss this response, please feel free to contact the undersigned by telephone at (212) 891-3942.

Respectfully submitted,

Dated: June 13, 2003



Frank M. Gasparo, Esq.
Reg. No. 44,700
BAKER & MCKENZIE
805 Third Avenue
New York, New York 10022
Telephone (212) 751-5700
Facsimile (212) 759-9133